

**REMARKS**

Reconsideration of the final rejection of all claims is respectfully requested in view of the above amendments and the following remarks.

***Claim Amendments***

Claims 22-24 have been newly cancelled herein and claims 1-10 and 21 have been amended in the manner noted below:

**Claims 1-10 and 21** have been amended to remove the reference to an “*in vivo* hydrolysable ester” of the claimed or administered compounds. It has been noted that the pending claims do not involve any free hydroxy or carboxy groups within their scope, and therefore an *in vivo* hydrolysable ester would not be formed.

Claims 11-20 were previously cancelled.

**Method claim 21** has been narrowed in scope from a method for “producing a cell cycle inhibitory (anti-cell-proliferation) effect” to be directed specifically to a method for the treatment of rheumatoid arthritis, which the Examiner has noted at page 3 of the Action is enabled by the present specification. Rheumatoid arthritis is discussed in the specification, *inter alia*, at page 21, lines 20-25, as being a cell proliferation disorder, to which the cell cycle inhibitory (anti-cell-proliferation) effect claimed by claim 21 was directed prior to this narrowing amendment. Inasmuch as this amendment directly addresses the Examiner’s rejection, limits this claim to a method said to be enabled, is supported by the specification and is within the scope of the generic method of this claim before amendment, entry of this amendment is believed to be in order after final rejection, and is respectfully requested.

**Method claims 22-24** have been newly cancelled.

The above amendments are being made for the purpose of expediting the prosecution of this application to allowance, and are being made without waiver or prejudice to Applicants’ right to prosecute subject matter deleted thereby in one or more continuing applications. It should be apparent from the above that no new matter is added by these amendments. Inasmuch as the claim amendments narrow the scope of the claims and place the claims in condition for allowance, entry thereof after final rejection is believed to be in order and is respectfully

requested. Following entry of these amendments, claims 1-10 and 21 remain pending in the Application.

### ***Claim Rejections***

The Examiner notes at page 2 of the Action that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks. Therefore, only the rejections that are expressly noted as having been maintained will be addressed herein.

In particular:

- The Examiner has withdrawn the obviousness-type double patenting rejection over claims of U.S. Patent 6,969,714 by reason of the Terminal Disclaimer filed herein relative to that patent on January 10, 2008; and
- The Examiner has withdrawn the provisional obviousness-type double patenting rejection over claims of copending Application No. 10/507,162 upon determining that the claims of that application and the present application are not overlapping. In that regard, Applicants note that 1-methoxyprop-2-yl was removed from the R<sup>4</sup> definition in the claims of Application No. 10/507,162 by the amendment filed in that application on August 17, 2007, which is believed to remove any possible overlap between the claims of that application and the claims of the present application.

### ***Provisional Obviousness-Type Double Patenting over Copending Applications No. 10/507,163 and No. 10/507,081***

The Examiner has continued the obviousness-type double patenting rejection with respect to currently pending claims of Applications No. 10/507,163 and No. 10/507,081.

Claims 1-6, 8-10 and 21-24 have been *provisionally* rejected for nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 22-25 of copending Application No. 10/507,163. This application is currently pending before Examiner Deepak R. Rao, with no allowed claims. A final rejection of all claims was mailed on March 18, 2008.

Claims 1-8, 10 and 21-24 have been *provisionally* rejected for nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 21, 33 and 35 of copending

Application No. 10/507,081. This application is currently pending before Examiner Deepak R. Rao, with no allowed claims. A final rejection of all claims was mailed on March 3, 2008.

Accordingly these obviousness-type double patenting rejections remain provisional, and Applicant is not able to meaningful address the rejections unless and until the claims are fixed in these application by allowance.

Nevertheless, in order to expedite the prosecution of the present application, a Terminal Disclaimer with respect to each of Applications No. 10/507,163 and No. 10/507,081 is submitted herewith, which Terminal Disclaimers obviate the present obviousness-type double patenting rejections. These Terminal Disclaimers are being submitted with the understanding that the filing thereof is not intended to be, and does not constitute, an admission that an obviousness-type double patenting rejection would be proper between the presently pending claims of either of these applications and the presently claimed invention (*see* MPEP 804.02II).

#### ***Claim Rejection - 35 USC § 112***

Claims 21-24 are newly rejected under 35 U.S.C. § 112, first paragraph, “because the specification, while being enabling for a method of treating rheumatoid arthritis, does not reasonably provide enablement for a method for producing a cell cycle inhibitory (anti-cell proliferation) effect; a method for the inhibition of CDK2, CDK4, or CKD6; or a method for treating cancer.”

While Applicants do not necessarily agree with this ground for rejection, method claims 22-24 have been cancelled and method claim 22 has been amended in an effort to advance the prosecution of this application to allowance. Specifically, claim 21 has been narrowed from being directed toward a “method for producing a cell cycle inhibitory (anti-cell-proliferation) effect” to a “method for treating rheumatoid arthritis,” in accordance with the above acknowledgement by the Examiner that a method for treating rheumatoid arthritis is enabled by the present specification. Rheumatoid arthritis is discussed in the specification, *inter alia*, at page 21, lines 20-25, as being a cell proliferation disorder, to which the cell cycle inhibitory (anti-cell-proliferation) effect claimed by claim 21 was directed prior to this narrowing amendment.

Accordingly, it is believed that this ground for rejection has been overcome, and it is respectfully requested that this ground for rejection be withdrawn.

***Updated Statement Regarding Technically Related Pending Applications***

Applicants wish to update the Examiner with respect to the current status of the following technically related applications of Applicants' assignee, which applications were previously discussed at page 13 of the Amendment and Response filed herein November 19, 2007.

**US Application 10/507,081** is currently pending before Examiner Deepak R. Rao, and an Action finally rejecting all claims was mailed on March 3, 2008. This application has been cited in a provisional obviousness-type double patenting rejection in the present application, which has been overcome by the Terminal Disclaimer filed herewith as discussed above.

**US Application 10/507,162** is currently pending before Examiner Deepak R. Rao. An Amendment after final rejection was filed December 17, 2007, resulting in a Notice of Allowance mailed December 27, 2008. A Request for Continued Examination was filed on January 16, 2008 together with an Amendment an Information Disclosure Statement citing several additional documents (which documents were formally cited in the present application with the Information Disclosure Statement filed January 30, 2008). This '162 application was previously cited in a provisional obviousness-type double patenting rejection in the present application, but has been withdrawn in the Action as discussed above.

**US Application 10/507,163** is currently pending before Examiner Deepak R. Rao, and a final rejection of all claims was mailed on March 18, 2008. This application has been cited in a provisional obviousness-type double patenting rejection in the present application, which has been overcome by the Terminal Disclaimer filed herewith as discussed above.

**US Application 10/556,561** is currently pending before Examiner Venkataraman Balasubramanian, and a Notice of Allowance was mailed on May 13, 2008.

**US Application 10/556,607** has been assigned to Examiner Deepak R. Rao, and a first Action is predicted to be mailed in 4 months from the present date.

**US Application 10/586,954** has been assigned to Examiner Deepak R. Rao, and a first Action is predicted to be mailed in 6 months from the present date.

**US Application 11/793,254** is still undergoing preexam processing and has not yet been assigned to a Group Art Unit or to an Examiner, and no prediction is available as of yet as to when a first Action might be mailed. However, a response to a Notice to File Missing

Requirements was filed on May 12, 2008, together with a further Information Disclosure Statement and a Preliminary Amendment.

**US Application 11/817,389** is still undergoing preexam processing and has not yet been assigned to a Group Art Unit or to an Examiner, and no prediction is available as of yet as to when a first Action might be mailed.

It is understood that the Examiner has full electronic access to each of these files. However, the undersigned would be happy to provide the Examiner with paper copies of any documents in these files upon requested, rather than inundating the US PTO and the Examiner at this time with unwanted paper.

### ***Conclusion***

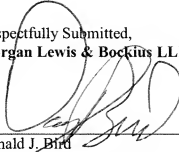
All remaining grounds for rejection have been addressed and, it is believed, overcome. Specifically, the remaining obviousness-type double patenting rejections have been obviated by the filing of Terminal Disclaimers herewith, and the new section 112, first paragraph, non-enablement rejection has been overcome by cancelling method claims 22-24 and narrowing claim 21 to a method for treating rheumatoid arthritis, which the Examiner has noted is enabled. Accordingly, it is believed that this application is now in condition for allowance, and a notice to that effect is respectfully requested.

However, if any issues remain outstanding after consideration of the above, it is respectfully requested that the Examiner telephone the undersigned to explore whether an expedited resolution might be obtained.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit

Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,  
**Morgan Lewis & Bockius LLP**



By:

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